In the Supreme Court of the United States.

AUTOMATIC SWITCH COMPANY OF BALTIMORE CITY, vs. CUTLER-HAMMER MFG. COMPANY.	In Equity.

Motion For Leave to File Annexed Petition.

And now comes the above-named Automatic Switch Company of Baltimore City, by Philip Mauro, Esq., its counsel, and makes application to this Honorable Court for leave to file its annexed Petition praying for the Writ of Mandamus, or of Certiorari, or both writs ; and further requests that an order to show cause may be granted, directed to the United States Circuit Court of Appeals for the Second Circuit, requiring said Court, or the Judges thereof, to show cause why the Writ of Mandamus should not be granted as prayed in said Petition.

There is a single question of law involved, relating to the right of appeal, which has been decided in favor of that right by the U. S. Circuit Court of Appeals for the Seventh Circuit, while the said Court of Appeals for the Second Circuit has refused that right in the present cause.

New York City, Jan. 8, 1906.

AUTOMATIC SWITCH COMPANY OF BALTIMORE CITY.

By

PHILIP MAURO,

Of Counsel.

IN THE SUPREME COURT OF THE UNITED STATES.

AUTOMATIC SWITCH COMPANY OF BALTIMORE CITY, Complainant-Appellee and Cross-Appellant and Petitioner, vs. CUTLER-HAMMER MFG. COMPANY, Defendant-Appellant and Cross-Appellee.	In Equity.

Petition.

TO THE HONORABLE THE SUPREME COURT OF THE UNITED STATES:

Your Petitioner, the Automatic Switch Company of Baltimore City, a corporation of the State of Maryland, having its principal office and place of business in the City and State of New York, respectfully showeth:

I.

1. Your Petitioner is the owner of the entire right, title and interest in and to U. S. Letters-patent No. 499,769, granted to George H. Whittingham on June 20, 1893, for an Automatic Switch or Regulator for Electric Motors. Heretofore your Petitioner brought its suit in equity in the Circuit Court of the United States for the Southern District of New York against the Cutler-Hammer Mfg. Company, complaining of infringement of the said U. S. Letters-patent by the said defendant. The case duly coming on to be heard, an opinion was filed by his Honor WILLIAM K. TOWNSEND, United States Circuit Judge (reported in 139 Fed. Rep. 870), sustaining the validity of Claims 4, 5, 6, 7 and 8 of the said patent, all the claims sued on, and holding Claims 4 and 5 infringed but the other three claims *not* infringed; and thereupon, on

April 20, 1905, an Interlocutory Decree was entered by the said Court awarding an injunction and accounting in favor of your Petitioner and against said defendant upon Claims 4 and 5 aforesaid, and adjudging that Claims 6, 7 and 8 were not infringed (but not dismissing the bill as to those three claims), and granting your Petitioner one-half its costs; and at the same time an Order of Suspension was entered by the said Court suspending the operation of said injunction pending an appeal to the United States Circuit Court of Appeals for the Second Circuit. Copies of the said Whittingham patent, of the said Opinion, of the said Interlocutory Decree granting the injunction, and of the said Order suspending the injunction, are ready to be produced as part of this Petition.

2. Thereafter, on May 12, 1905, the said defendant took its appeal from the said Interlocutory Decree to the U. S. Circuit Court of Appeals for the Second Circuit, and on the same day the citation was signed by the Honorable E. HENRY LACOMBE, United States Circuit Judge, and the Circuit Court lost jurisdiction of every matter in controversy—except as to Claims 6, 7 and 8, as to which matters alone that Court still retained its jurisdiction; and thereupon the entire record was duly certified up to the said Court of Appeals.

3. That on May 26, 1905, there was signed and entered in the said Circuit Court a "Final Decree as to Claims 6, 7 and 8," disposing finally of all matters then remaining before that Court, by dismissing the Bill of Complaint as to those three Claims of the said Whittingham patent; whereupon, on June 7, 1905, complainant (acquiescing in the dismissal as to Claim 8) took its appeal from the said Final Decree as to Claims 6 and 7 of the said Whittingham patent, to the said U. S. Circuit Court of Appeals for the Second Circuit, and the citation was signed by the Honorable E. HENRY LACOMBE aforesaid on the same day. Copies of the said Final Decree as to Claims 6, 7 and 8, of the said Appeal therefrom, and of the Assignments of Error in support thereof, are ready to be produced as part of this Petition.

4. Thereafter, by agreement between the parties, each party, for the purpose of said appeals, supplied sufficient

printed copies of its own record in the Court below and paid in advance one-half of the costs for perfecting the appeal, as estimated by the Clerk of the said Court of Appeals.

5. Thereafter, and after said printed copies had been furnished by your Petitioner, and the money for the said one-half of the estimated costs had been paid by your Petitioner, the said defendant-appellant and cross-appellee, the Cutler-Hammer Mfg. Company, moved to dismiss your Petitioner's said appeal upon the ground that the said Court of Appeals had no jurisdiction to entertain the same, and said defendant gave notice that it would claim a *Preference;* after due deliberation, the said Court of Appeals on December 21, 1905, indicated its decision by the words "*Motion granted*", but without assigning any reason or giving any written or oral opinion; and in pursuance thereof, on January 3, 1906, an Order was entered dismissing your Petitioner's said appeal. A copy of the said Motion to dismiss the appeal is ready to be produced as a part of this Petition; and a certified copy of said Order of Dismissal is annexed hereto.

II.

6. Your Petitioner shows that there is a single question of law here involved, to wit: "Where, in a patent suit in equity, after final hearing upon pleadings, proofs, and exhibits, there has been a decision upon the merits, and an *interlocutory* decree granting an injunction as to certain Claims of the patent in suit, and defendant has taken its appeal from said interlocutory decree and has already carried up the *entire record* to the Court of Appeals; and where there is a *subsequent* FINAL DECREE dismissing the bill as to other claims of the same patent; has the Court of Appeals jurisdiction to entertain an appeal from that subsequent decree?

This question has been decided affirmatively, in favor of the jurisdiction of the Courts of Appeals to entertain such cross-appeals, by the U. S. Circuit Court of Appeals for the Seventh Circuit in *Chicago Wooden Ware Co. vs. Miller Ladder Co.*, 133 F. R. 541, 544-5, relying upon the decision of this Court in *Smith vs. Vulcan*, 165 U. S., 518. And a similar result has been reached by the United States Circuit Court of

Appeals of the Fourth Circuit in *Scriven vs. North*, 134 F. R., 366, 368-9.

Whereas, it has been decided in the negative in the present case, the U. S. Circuit Court of Appeals for the Second Circuit having refused to entertain jurisdiction.

7. Your Petitioner shows that the term of its patent is running out, and in the meantime the defendant is not under injunction and is infringing extensively; and that your Petitioner will be irreparably injured by delay and will be grievously and irreparably injured if it be not allowed to prosecute its said appeal as to Claims 6 and 7 and argue the same at the same time with defendant's appeal as to Claims 4 and 5. Among other reasons why your Petitioner would be injured by having to argue the cause *piecemeal* before the said Court of Appeals, your Petitioner shows the following:

(a) Should the Court of Appeals *affirm* the decision of the Circuit Court, the parties would have to proceed with the accounting; and thereafter your Petitioner would have to renew its appeal as to Claims 6 and 7, or forego all rights thereunder as against this defendant,—thus necessitating a *second appeal*, and *a second consideration* by the Court of Appeals of all matters here involved.

(b) Furthermore, should this second appeal be *sustained* in your Petitioner's favor, there would have to be a *second accounting*, which might or might not proceed upon a different theory from that employed in the first accounting, which would then be followed by a *third appeal*. (See *Scriven vs. North*, 134 F. R., 366.)

(c) Should the Court of Appeals *reverse* the Circuit Court and order the bill dismissed as to Claims 4 and 5, your Petitioner would then have to renew its appeal as to claims 6 and 7, and present the same (and additional) matters *a second time* before the Court of Appeals, which might be followed by an accounting and then a *third appeal*.

(d) Your Petitioner fears, and has reason to fear, in view of the decision of this Court in *Hill vs. Chicago R. R. Co.*, 140 U. S., 52, that if it should hereafter renew its appeal from the dismissal as to Claims 6 and 7, entered on May 26, 1905, the Court of Appeals will hold such appeal too late, not having been taken within six months from the said date,—

so that your Petitioner would be altogether without remedy in the premises.

(e) Your Petitioner further shows that the Claims involved in its appeal (Claims 6 and 7), and the Claims involved in defendant's appeal (Claims 4 and 5) are so closely related that consideration of either group requires and demands consideration of the other group of Claims and comparison of the two groups; and your Petitioner fears, and has reason to fear, that the Judges who would hear and decide any renewed appeal by your Petitioner as to Claims 6 and 7, might feel themselves precluded by the language employed by the Judges who shall have decided the defendant's appeal as to Claims 4 and 5, even though the last-named Judges had not intended any such effect to be given to their decision.

WHEREFORE, and for the reason that unless this Court commands the United States Circuit Court of Appeals for the Second Circuit to receive and entertain your Petitioner's said appeal, your Petitioner will be utterly without remedy in the premises, your Petitioner respectfully prays that a Writ of MANDAMUS may be granted out of and under the seal of this Honorable Court directed to the United States Circuit Court of Appeals for the Second Circuit, commanding that Honorable Court to receive and entertain your Petitioner's said appeal; or in the alternative that a Writ of CERTIORARI may be granted in like manner, directing the said Honorable Court of Appeals to certify to this Court, for determination by this Court, the question of law set forth in paragraph 6 of this Petition, together with such papers and proceedings relating thereto as may be necessary for the proper consideration and determination of said question; or that both of said writs may be granted; and your Petitioner likewise prays for such other and further relief as the case may require.

And your Petitioner will ever pray.

Dated New York City, January 8th, 1906.

AUTOMATIC SWITCH COMPANY OF BALTIMORE CITY.
by C. A. L. MASSIE
of Counsel.

PHILIP MAURO,
C. A. L. MASSIE,
Of Counsel for Petitioner.

STATE OF NEW YORK, }
County of New York, } ss.:

C. A. L. MASSIE, being duly sworn, deposes and says that he is of counsel for the petitioner herein and has had charge of this litigation from its beginning; that he has read the foregoing petition and knows the contents thereof and that the same are true to his own knowledge.

C. A. L. MASSIE.

Subscribed and sworn to before me this 4th day of January, 1906.

RALPH LANE SCOTT,
Notary Public,
New York County.

[SEAL.]

Certified Copy of Order of Dismissal.

IN THE UNITED STATES CIRCUIT COURT OF APPEALS

FOR THE SECOND CIRCUIT.

Present: HONS. W. J. WALLACE, E. H. LACOMBE, and A. C. COXE, United States Circuit Judges.

AUTOMATIC SWITCH COMPANY OF BALTIMORE CITY, Complainant-Appellee and Cross-Appellant, vs. THE CUTLER-HAMMER MFG. CO., Defendant-Appellant and Cross-Appellee.	In Equity, Calendar No. 118.

This cause coming on to be heard upon motion by the said Cutler-Hammer Mfg. Company to dismiss the cross-appeal of

the said Automatic Switch Company of Baltimore City, upon the ground that this Court has no jurisdiction to entertain the said cross-appeal; and W. Clyde Jones, Esq., being heard for the motion, and C. A. L. Massie, Esq., being heard in opposition, and each party having filed a printed brief; and the Court being duly advised in the premises;

Now, therefore, it is hereby ADJUDGED, ORDERED and DECREED that the said motion be and the same hereby is granted and that the said cross-appeal taken by the said Automatic Switch Company of Baltimore City be and the same hereby is dismissed upon the ground that this Court has no jurisdiction to entertain the same.

Dated, Jan. 3, 1906.

A true copy,
(Signed) WM. PARKIN,
Clerk (SEAL).

(Sgd)
E. H. L.
A. C. C.

Filed Jan. 3, 1906.

IN THE SUPREME COURT OF THE UNITED STATES.

AUTOMATIC SWITCH COMPANY OF BALTIMORE CITY vs. CUTLER-HAMMER MFG. COMPANY.	In Equity.

BRIEF IN SUPPORT OF PETITION.

I. Forms of Procedure.

From the facts stated in the Petition we shall show that the Automatic Switch Company of Baltimore City is entitled to have its appeal entertained by the United States Circuit Court of Appeals for the Second Circuit, as a matter of right; also, that we will be seriously and irreparably injured by the refusal to entertain jurisdiction of the appeal. MANDAMUS is the appropriate remedy to compel allowance of an appeal in a proper case.

Beach Mod. Eq. Pr., Sec. 954, p. 930.
Ins. Co. vs. Comstock, 16 Wall., 258.
Vigo's case, 21 Wall., 648.
Rd. Co. vs. Wiswall, 23 Wall, 507.
Ex parte Jordan, 94 U. S., 248.
Ex parte R. R. Co., 95 U. S., 221.
Ex parte Parker, 120 U. S., 737.
Hollon Parker, 131 U. S., 221.
Matter of Christensen Co., 194 U. S., 458.

See, also,
Ex parte Hohorst, 150 U. S., 653.

Moreover, where one Circuit Court of Appeals has decided a question one way, and another Circuit Court of Appeals has decided a similar question in the contrary manner—the decision in the Second Circuit (here complained of) is contrary to the decision in the Seventh Circuit (Chicago, &c., Co. vs.

Miller, 133 F. R., 541, 544-5) and of the Fourth Circuit (Scriven vs. North, 134 F. R., 366, 368-9)—a situation is presented that calls for *certiorari* in order that the Supreme Court may declare the correct practice, and in order to secure uniformity of decision. See:

Smith vs. Vulcan Iron Works, 165 U. S., 518.
Amer. Construction Co. vs. Jacksonville, &c., Co., 148 U. S., 372.
Forsyth vs. Hammond, 166 U. S., 506.
United States vs. Three Friends, 166 U. S., 1.
In re John Woods, 143 U. S., 202.
Lau Ow Bew, 144 U. S., 47.

II. Our appeal was from a final decree.

Our appeal, which the Circuit Court of Appeals has refused to entertain, was taken from a "*Final Decree.*" The "Interlocutory Decree" of April 20, 1905, divided the claims into two groups, and held Claims 4 and 5 valid and infringed and the other three Claims (6, 7 and 8) also valid but *not* infringed; this Interlocutory Decree sustained the bill as to the first group by awarding an injunction and an accounting, with one-half of the costs, but it *did not dismiss the bill as to Claims 6, 7 and 8.* As to these three Claims, the bill was still undisposed of one way or the other. About three weeks later, on May 12, the defendant appealed from said "Interlocutory Decree," and the appeal was duly allowed. The allowance of the appeal carried to the Circuit Court of Appeals the subject-matter involved and completely ousted the jurisdiction of the Circuit Court *as to such matters.* Therefore, after defendant had appealed, the extent of jurisdiction still retained by the Circuit Court, was only as to Claims 6, 7 and 8. The Circuit Court had jurisdiction as to these Claims, and had no other jurisdiction.

Consequently, when two weeks later, on May 26, we entered a decree disposing of the bill as to Claims 6, 7 and 8, this decree completely and finally disposed of everything then remaining before the Circuit Court. There remained nothing further for the Circuit Court to decide or dispose of. Even the matter

of costs had already been determined under and by virtue of the prior "Interlocutory Decree." Such decree is final.

See Hill vs. Ry. Co., 140 U. S. 52.
Grant vs. E. & W. R. Co., 50 F. R., 795.
Forgay vs. Conrad, 47 U. S., 200.
Potter vs. Beale, 50 F. R., 860.
Scriven vs. North, 134 F. R., 336, 368.
City of New Orleans vs. Peake, 52 F. R., 74.
Beach Mod. Eq. Br., § 913, p. 895.

A text writer puts it :

> "Where a decree dismissed a bill as to all matters except one which was severable from the rest, as to which a subsequent decree was entered, it was held that the right to appeal from the first dismissal began to run from the entry of the first decree" (Foster's Fed. Pr. (2d Ed.), § 483, p. 1038, citing *Hill vs. Ry., supra;* and *Central Trust Co. vs. Locomotive Co.*, 135 U. S., 207).

Paraphrasing this :

> "Where a decree *sustained* a bill as to certain matters [Claims 4 and 5] but not as to certain other matters [Claims 6, 7 and 8] which were severable from the rest, as to which latter a subsequent decree was entered *dismissing the bill*, it must be held that the right to appeal from that dismissal begins to run from the entry of that decree of dismissal."

In *Hill vs. Ry. Co.* (140 U. S., *supra*), a decree was entered directing an accounting as to certain matters as against certain defendants, ordering that the bill be dismissed as to certain other matters and as against certain other defendants, and declaring that upon return of the master's report such further decree would be rendered as might be equitable. This decree was called an *interlocutory* decree. When the accounting was completed a final decree was entered, which besides ordering payment of the amount found by the accounting, etc., again decreed that all other relief prayed for by the complainant be denied (140 U. S., p. 53, line 33). Thereupon, complainant appealed from this so-called "Final Decree" but the Supreme

Court held that the so-called " Interlocutory Decree " was in reality a *final decree* as to the matters ordered dismissed [*e. g.*, in this case, as to Claims 6, 7 and 8] ; and that the appeal was therefore taken too late. Consequently the complainant was remediless.

The case was cited with approval in *Bank vs. Smith*, 156 U. S., 330, 335.

III. Act of 1900.

In the foregoing discussion we have taken the ground that the subject-matter of the " Final Decree " of May 26 was *severable* from the subject-matter of the " Interlocutory Decree " of April 20, 1905. The Opinion of the Court made a distinction between them, the two Decrees themselves made the distinction, and defendant's Appeal has made the distinction. Nevertheless, it may be urged that in reality there is but *one* decree, and that the paper dated May 26 is but an amendment or supplement of the paper of April, and that the two might have been and usually are formulated as one paper. That may be true, but in the present case there *are* two separate decrees—one (as to Claims 4 and 5) " interlocutory," because there yet remains the Master's report before a *final* decree can be entered ; and the other (as to Claims 6, 7 and 8) " *final*," because it disposes completely of the entire subject matter before it.

Therefore, it must follow either that the two papers relate to *severable* matters, or that they constitute different parts of one and the same degree. If the former, then our appeal should be allowed without further discussion, as being from a *final* decree ; if the latter, it remains to discuss the effect to be given to the Act of 1900 relating to *interlocutory* decrees.

The language of this statute is plain and unambiguous : it is as follows :

> " SEC. 7. That where, upon a hearing in equity, in a district court or in a circuit court, or by a judge thereof

in vacation *an injunction shall be granted or continued* or a receiver appointed, *by an interlocutory order or decree*, in a cause in which an appeal from a final decree may be taken under the provisions of this Act to the Circuit Court of Appeals, *an appeal may be taken from such interlocutory order or decree granting or continuing such injunction*, or appointing such receiver to the Circuit Court of Appeals: Provided, that the appeal must be taken within thirty days from the entry of such order or decree, and it shall take precedence in the Appellate Court; and the proceedings in other respects in the court below shall not be stayed, unless otherwise ordered by that court, or by the appellate court or a judge thereof, during the pendency of such appeal: Provided further, that the court below may in its discretion require as a condition of the appeal, an additional bond."

The present cause, being a patent suit, is one "in which an appeal from a Final Decree may be taken * * * to the Circuit Court of Appeals," therefore it comes within the provisions of amended Section 7. Omitting the reference to the *continuing* of an injunction or the appointment of a *receiver* (with which we are not here concerned), and omitting the reference to an interlocutory *order* (as distinguished from an interlocutory *decree*), the material provisions of this Act are as follows:

> "SEC. 7. That where * * * an injunction shall be granted * * * by an interlocutory decree * * * *an appeal may be taken* from such interlocutory decree * * * to the Circuit Court of Appeals. * * *"

There is no question that the "Decree" here in question—made up of the two portions entered in April and May respectively—is "an interlocutory decree granting an injunction;" therefore, there can be no question but that "*an appeal may be taken* from such interlocutory decree." The language is so unambiguous that any construing thereof is superfluous and uncalled for. Nevertheless, this Court in

Smith vs. Vulcan Iron Works (165 U. S., 518) felt called on to say that this Act

> " authorizes, according to its grammatical construction and *natural meaning*, an appeal to be taken from the *whole* of such interlocutory order or decree, and not *from that part of it only which grants or continues an injunction.*"

The Court continues:

> " The manifest intent of this provision * * * appears to this Court to have been * * * also to save both parties from the expense of further litigation * * *."

Accordingly, if we assume that the paper of April and that of May amount to a single " interlocutory decree," then (when an appeal has been taken) the Court of Appeals is authorized by the Statute, " according to its grammatical construction and natural meaning," to consider " the *whole* of such interlocutory decree, and not (from) *that part of it only which grants or continues an injunction.*" [On the other hand, if the two Decrees are distinct and severable, then the Decree of May is *final*, and therefore appealable at once.]

This view of the decision in *Smith vs. Vulcan Works* is taken by the Court of Appeals in the Seventh Circuit (rendered May 12, 1904), which we believe is the latest decision on this precise question.

> *Chicago Wooden Ware Co. vs. Miller Ladder Co.*, 133 F. R., 541, 544-5.

The same result was reached by the Court of Appeals for the Fourth Circuit, in an even later decision, rendered November 15, 1904, in

> *Scriven vs. North*, 134 F. R., 366, 368-9.

Even in the First Circuit it has been held that when the " *full record* " is brought before the Court of Appeals, the Court " may go *fully into the merits.*"

> *Marden vs. Campbell Mfg. Co.*, 67 F. R., 809 (5th syllabus).

It must be noted that Congress did not undertake, by express language, to limit the right of appeal from such interlocutory decree *to the defendant only*. Had this been the intention of Congress, it would have been very easy to express it. Instead of saying "* * * an appeal may be taken *by the defendant* from such interlocutory order or decree, * * *" the Act reads as it does, saying simply, "an *appeal* may be taken,"—leaving open to whoever is aggrieved by such decree (be he complainant or defendant) to take "an appeal."

The argument has been made that the history of the various amendments to the Evarts Act demonstrates that Congress has *intended*, by the Act of 1900, to limit the right of an appeal to the defendant. The argument runs as follows: (1) Under the original Act of 1891, Section 7 grants the right to an appeal from an interlocutory order or decree granting or continuing such injunction. Following this Act came numerous decisions denying *complainant's* right to a cross-appeal where the decree was partly in his favor and partly against him; thereafter came the amendment of 1895, enlarging the right of appeal so as to permit an appeal from an interlocutory order or decree *refusing* the injunction. And (2) that, by the Act of 1900, Congress restored the conditions existing under the original Act of 1891 (except to render the appointment of a receiver appealable); and that, in consequence, Congress intended to sanction the decisions aforesaid, rendered before 1895.

The answers to this argument are plain: First, as a matter of fact, the Act of 1900 purports to amend the Act of *1891*, and ignores the intervening Act of 1895. It is generally believed in the profession and (we believe) on the bench, that the lawmakers overlooked the Act of 1895; in fact, this has been judicially stated in a reported opinion. At any rate, the plain effect of the Act of 1900 is merely to take away the right to appeal from an interlocutory order or decree refusing an injunction (while creating the right to appeal from the appointment of a receiver). This distinction is all that is necessary to support the present Act, and to render the actions of Congress consistent; while to construe the Act of 1900 as going further than this, unnecessarily deprives every complainant of a valuable right. Second, Congress could not have *intended* to

approve the Circuit Court of Appeal's decisions (referred to as rendered before the Act of 1895), because these were not decisions *by the Supreme Court.* The law-makers had a right to assume that an aggrieved complainant cross-appellant could apply to the Supreme Court of the United States for a proper interpretation of the Statute, as in fact was done in the case of *Smith vs. Vulcan,* (165 U. S., *supra*).

Real Purpose and Effect of the Acts.

Before the Evarts Act, no appeal could be taken from an *interlocutory* decree, but an appeal could be taken from any *final* decree; in fact, *both parties* could appeal from a final decree, each appealing from so much thereof as was against him. By the Evarts Act and the various amendments thereto, Congress has undertaken to take certain specific interlocutory decrees out of the class of *non*-appealable decrees and place them in the class of *appealable* decrees. Consequently, if an interlocutory decree come within this class of "appealable decrees," then (for all purposes of taking the appeal) it follows the nature of an *appealable* "final decree," that is, just as each party can appeal from so much of a final decree as is against him, so each party may appeal from so much of an appealable interlocutory decree as may be against him. Now the Act as it stands at present places "*an interlocutory decree that grants an injunction*" within the class of "appealable decrees;" consequently, either party who is aggrieved by it may appeal therefrom.

All interlocutory decrees must fall within one of two classes: 1st, those that grant an injunction, and 2d, those that do *not* grant an injunction (viz., *all other* interlocutory decrees). Where an interlocutory decree grants an injunction as to one claim of a patent and refuses injunction as to another claim, such decree falls within the first class, and is appealable. The fact that *an injunction is granted* is what determines the character of the decree. Therefore we believe that under the plain grammatical meaning of the Act of 1900, where an interlocutory decree *grants an injunction* as to one claim of the patent while refusing it as to another claim, such decree is appealable, and the complainant who is aggrieved by such decree (in

that he has not received complete relief) has the right to appeal from the decree *as a whole* (*Smith vs. Vulcan, supra*).

Nevertheless, the grounds of our present application are much stronger than this, and it is not necessary for this Court to go to the extent just indicated.

Ours is a Cross-Appeal.

In the present case the defendant has already appealed, and has already taken up to the Court of Appeals the *entire record*. The whole subject matter of this litigation is now before that Court. The entire matter must be examined and considered by that Court, and that Court has authority to examine and dispose of *every* question (*Smith vs. Vulcan, supra*).

Even if we concede that a complainant cannot appeal from an interlocutory decree that is partly for him and partly against him, except by way of cross-appeal (where the defendant has *already* taken up the entire record), yet in case of such appeal *by defendant*, reason and analogy, and considerable authority too, demand that complainant's cross-appeal be entertained.

Analogies. Where a court of equity has no equitable ground for jurisdiction, it will refuse to entertain a suit for patent infringement; but where the court had some equitable ground for jurisdiction when the bill was filed, then, although the patent has meantime expired, the court will retain jurisdiction for the purpose of the accounting. Again, where a Federal Court entertains jurisdiction of a controversy by reason of *diversity of citizenship*, it will permit a Bill of Revivor, or the like, between parties who are citizens of the *same* State, upon the ground that it had already acquired jurisdiction of the entire subject matter. In like manner, where one Federal Court has jurisdiction of a suit by reason of *diversity of citizenship*, another Federal Court will entertain proceedings ancillary thereto between citizens of the *same* State, upon the ground that jurisdiction over the main subject matter is in the original Federal Court. Again, under the common law system of pleading, upon demurrer to a *replication*, if the *replication* prove bad, but there is a substantial fault in the *plea* to which it was addressed, judgment will be for the plaintiff, provided the *declaration* be good, but if the *declara-*

tion also be bad, then judgment for the defendant; thus the court will consider the whole matter before it, and not confine itself to the precise question which the parties themselves brought up. Other illustrations might be added to teach this commonsense doctrine—namely, where the court has once obtained jurisdiction of the entire subject-matter—we mean a Court of Equity—it will do *complete* justice to *all* the parties before it; and will decide *all* the questions and matters involved,—even such matters as, if presented alone, would not come within the jurisdiction of the court. So, in the present case, the Court of Appeals has already obtained jurisdiction over the *entire* subject-matter (by virtue of *defendant's* appeal), and should, therefore, decide the *entire* case, and *upon its merits*. The question stated in the *Smith-Vulcan* case was "whether the Circuit Court of Appeals, upon such an appeal, may consider and decide the *merits* of the case." * * * It is inconceivable that the Court of Appeals having the right to "consider and decide the merits of the case" could decide them in defendant's favor if the merits lay with him, yet could not decide the whole matter in complainant's favor, if the merits be with the latter.

"Reasons" Assigned Against Jurisdiction.

The decisions of Courts of Appeals that are cited as holding against the right of cross-appeal under such circumstances, are based upon two propositions: First, the supposed verbal requirements of the statute; and, second, the dread of having to hear an appeal "piece-meal." The *first* ground is untenable in view of the decision of this Court that the "grammatical construction and natural meaning" of the statute permits "an appeal to be taken from the *whole* of such interlocutory order or decree, and not from *that part of it only that grants or continues an injunction.*"

SECOND. Among the leading cases cited against the right of complainant to maintain its cross-appeal under the circumstances here presented, is *Western Electric Co. vs. Williams-Abbott Co.*, 108 F. R., 952 (6th Circuit). The Court below dismissed the bill as to claim 1 but sustained it as to claims 2

and 3; both parties appealing, the defendant's appeal was successful, the Court below being directed to dismiss the bill as to claims 2 and 3, but complainant's appeal was dismissed because prematurely taken. Of course, the next step would be the entry of a decree in the Court below, pursuant to the mandate, dismissing the bill as to all three claims, followed by complainant *then* taking his appeal on claim 1. The Court of Appeals thus invited and forced a *second* appeal. Truly a marvelous way to avoid "piece-meal consideration."

Precisely the same situation is possible here. Let us assume that the Court of Appeals hears argument on *defendant's* appeal, having refused to entertain *our* cross-appeal, and thereafter gives up its time to a careful study of the entire record, resulting (*absit omen*) in sustaining defendant's appeal; thereupon the Circuit Court will be ordered to dismiss the bill as to claims 4 and 5; *after all of which* complainant will finally be permitted to return to the same Court of Appeals with its appeal as to claims 6 and 7, and that Court will then have to re-examine the same record. In other words that Court has the complete record before it *now*, and *one* examination of the record, *one* study of the questions involved, will suffice to pass upon the merits of both appeals; to do otherwise would require the argument by counsel and consideration by the Court of *one* appeal now and of the *second* appeal hereafter. Finally, if our cross-appeal stand dismissed, and if defendant's appeal be decided in *our* favor, the accounting will proceed as to claims 4 and 5 only; and if thereafter, on a *future* appeal, we succeed as to the other claims, there would have to be a second accounting, leaving room for a *third* appeal.

Even in another case cited as against the right to such cross-appeal, *Marden vs. Campbell* (67 F. R., 809), the distinction was noted between a case where the entire record was already before the Court of Appeals, and a case where a complainant sought to maintain his appeal independently. In short, the "reasoning" that warrants permitting defendants to appeal, is equally applicable and equally cogent in requiring that *complainants'* cross-appeal be entertained.

Accordingly, the Court of Appeals in the Seventh Circuit, upon the authority of the then recent decision of this Court in

Smith vs. *Vulcan* (165 U. S., *supra*) expressly sustained the right to the cross-appeal.

Chicago Wooden Ware Co. vs. Miller Ladder Co., 135 F. R., 541, 544–5.

This Court cited with approval the decision of the Court of Appeals for the Sixth Circuit, where it was said that if the Court of Appeals

> " obtained such a record as to enable it, with justice to the parties to the appeal, to hear and consider the merits of the case, it would be most anomalous if we have not the power to decide. The judicial function of considering involves the function of determining," etc.
>
> Bissell Carpet Sweeping Co. vs. Goshen Co., 72 F. R., 545, 560.

In the Second Circuit Judge WALLACE said:

> " Whenever the injunction is the main relief granted [and that is the case here] the whole case is necessarily presented for review."
>
> Florida Const. Co. vs. Young, 59 F. R., 721, 722.

Conclusions.

Our right to a cross-appeal has been demonstrated. The reasons why the Court of Appeals should consider our appeal concurrently with defendant's appeal, so as to avoid " piecemeal consideration," are fully set out in the second part of our petition.

Having been denied a plain right by the Court of Appeals, upon the ground that said Court has no *jurisdiction* to entertain our appeal, the writ of mandamus will lie; and because of the conflicting decisions in different circuits, *Certiorari* is proper.

Defendant's appeal now stands docketed for an early hearing by the Court of Appeals. Its counsel have given notice that they will claim a *Preference;* unless this Court renders its decision promptly, requiring the Court of Appeals to reinstate our cross-appeal, we will be compelled to argue the sole appeal of defendant; or the entire matter will have to be postponed until next Autumn or later, while defendant in the meantime will continue its infringement.

Therefore, we respectfully urge a prompt decision, either by way of mandamus or upon *certiorari*, directing the Court of Appeals to reinstate or cross-appeal.

New York City, January 8, 1906.

Respectfully submitted,

PHILIP MAURO,
HAROLD BINNEY,
C. A. L. MASSIE,
Of Counsel for Petitioner.

SUPREME COURT OF THE UNITED STATES.

No. 18, ORIGINAL, OCTOBER TERM, 1905.

EX PARTE IN THE MATTER OF AUTOMATIC SWITCH COMPANY OF BALTIMORE CITY, PETITIONER.

On consideration of the petition for a writ of mandamus herein,

IT IS NOW HERE ORDERED BY THE COURT that cause be shown by the Judges of the United States Circuit Court of Appeals for the Second Circuit before this Court at the City of Washington, on Monday, January 29th, 1906, at twelve o'clock noon of that day, or as soon thereafter as counsel can be heard, why the prayer of said petition should not be granted.

January 15, 1906.

[redacted]

[redacted]

[redacted]

[redacted]

[redacted]

[redacted]

[redacted]

[redacted]

[redacted]

Supreme Court of the United States.

NO. 18, ORIGINAL, OCTOBER TERM, 1905.

EX PARTE.

AUTOMATIC SWITCH COMPANY OF BALTIMORE CITY, PETITIONER.

STATE OF NEW YORK }
County of New York } ss.

C. A. L. MASSIE, being duly sworn, deposes and says he is of counsel for Petitioner herein, that he verified the Petition herein, and that the annexed nine papers are true copies of the original documents referred to in said Petition, and now on file either in the office of the Clerk of the Circuit Court of the United States for the Southern District of New York, or in the office of the Clerk of the Circuit Court of Appeals for the Second Circuit.

C. A. L. MASSIE.

Subscribed and sworn to before me this 20th day of January, 1906.

RALPH LANE SCOTT,
Notary Public,
New York County.

(SEAL)

At a Stated Term of the Circuit Court of the United States for the Southern District of New York, held in the Court Room thereof in the Federal Building in the Borough of Manhattan and City of New York this 20th day of April, 1905.

Present: Hon. William K. Townsend, United States Circuit Judge.

Automatic Switch Company of Baltimore City vs. Cutler-Hammer Manufacturing Company.	In Equity. No. 7827. On Whittingham Patent No. 499,769.

Interlocutory Decree.

This cause having come on to be heard on Jan. 13, 1905, upon amended bill of complaint, answer, replication, and proofs and exhibits on behalf of each party; and Philip Mauro, Esq., and C. A. L. Massie, Esq., having been heard for complainant and W. Clyde Jones, Esq., for defendant, and printed briefs having been submitted on each side; and a written opinion having been entered herein on Mar. 3, 1905; now, in conformity with said opinion, and on motion of Complainant's solicitor, Elisha K. Camp, Esq., it is this day—

Adjudged, ordered, and decreed that Complainant is a Maryland corporation entitled to maintain this suit and is possessed of the exclusive and beneficial ownership of the Letters-patent here in suit and of the invention therein set out and of all claims for infringement thereof; that the said Letters-patent

No. 499,769, granted June 20, 1893, to George Herbert Wittingham, as to Claims 4, 5, 6, 7, and 8 thereof, is good and valid in law; and that Defendant has a regular and established place of business within the Southern District of New York, and has infringed upon Claims 4 and 5 of said Letters-patent and upon Complainant's exclusive rights in the premises, by making and causing to be made, using and causing to be used, and selling and causing to be sold, within the Southern District of New York and elsewhere within the United States, "Regulators for Electric Motors" or "Automatic Switches" like "Complainant's Exhibit, Defendant's Apparatus", known also as Cutler-Hammer "Self Starters"; it is further

ADJUDGED, ORDERED, AND DECREED that a perpetual injunction issue out of and under the seal of this Honorable Court, against the defendant, enjoining and restraining said defendant and its successors, assigns, associates, attorneys, officers, servants, clerks, agents, and workmen, and each of them, forever from directly or indirectly making or causing to be made, using or causing to be used, selling or causing to be sold, any Regulator for Electric Motors or Automatic Switch or Self Starter like or substantially similar to the construction set forth in Claims 4 and 5 of said Letters-patent No. 499,769, or in either of said Claims; or like or substantially similar to the "Self Starter" apparatus made an exhibit herein as "Complainant's Exhibit, Defendant's Apparatus"; it is further

ADJUDGED, ORDERED, AND DECREED that this cause be referred to John A. Shields, Esquire, one of the Masters of this Court, he being especially qualified by reason of his experience in these matters, to ascertain and report to this Court an account of the number of infringing Automatic Switches or Self Starters either directly or indirectly made or used or sold by the said defendant in infringement of Claims 4 and 5 of the patent in suit, likewise of the number of such articles which the said defendant has on hand or under its control; and also

a statement of the gains, profits and advantages which the said defendant has received or which have accrued to it from or through the said infringement; and, further, to assess the damages the complainant has suffered in the premises, and to report all the foregoing to this Court with all convenient speed;

And that upon such an accounting the Complainant shall have the right to cause an examination of said defendant *ore tenus*, by commission, or otherwise, and also the production of the books, vouchers, exhibits, statements, documents, and machinery and premises of said defendant, as the said Master may direct; and that the said defendant attend for such purpose from time to time as the said Master shall direct; and it is further

ADJUDGED, ORDERED, AND DECREED that the defendant pay to the complainant one-half ot the costs, charges and disbursements of this suit, to be taxed by the Clerk; and that complainant have execution therefor against said defendant.

W. K. TOWNSEND,
U. S. Circuit Judge.

Approved as to form.

Order Suspending Injunction.

At a Stated Term of the United States Circuit Court, held in and for the Southern District of New York at the United States Courts and Post Office Building on the 21st day of April, 1905.

Present—Hon. William K. Townsend, Circuit Judge.

The Automatic Switch Company of Baltimore City, Complainant, against The Cutler-Hammer Manufacturing Company, Defendant.	In Equity. No. 7827.

A motion having been made herein on behalf of defendant for an order staying the issuance of injunction herein or suspending the operation of said injunction during the pendency of the appeal to be taken from the interlocutory decree to be entered herein upon such terms as to bond or otherwise as the Court may consider proper for the securing of the rights of complainant, and for such other and further relief in the premises as to the Court may seem just, and said motion having been duly noticed for March 17th, 1905, and thereupon having been adjourned by the direction of the Court and referred to Hon. William K. Townsend for hearing, and said motion having been duly brought on for argument on the 10th day of April, 1905,

Now, upon reading and filing the affidavit of Seward Davis, duly verified March 13th, 1905, the three affi-

davits of Arthur Berresford, duly verified March 11th and 13th, 1905, respectively, and the affidavit of Richard H. Mansfield, Jr., duly verified the 15th day of March, 1905, the affidavit of Marcellus Staley, duly verified the 15th day of March, 1905, and a certified copy of a certain assignment in writing dated July 10, 1902, duly executed and delivered by complainant herein and recorded the 12th day of July, 1902, in the Patent Office of the United States of Letters Patent No. 499,769, granted to George H. Whittingham on the 20th day of June, 1893, for Improvement in Regulators for Electric Motors, to Otis Elevator Company, and the affidavit of Frank R. Bacon, duly verified on the 8th day of April, 1905, filed on behalf of defendant in support of said motion, and the affidavit of C. A. L. Massie, duly verified the 10th day of April, 1905, and the affidavit of David H. Darrin, duly verified the 5th day of April, 1905, and a copy of assignment of said Letters Patent No. 499,769, dated April 6, 1905, from said Otis Elevator Company to The Automatic Switch Company, and after hearing W. Clyde Jones, Esq., in support of said motion, and C. A. L. Massie, Esq., and Harold Binney, Esq., in opposition thereto, and due consideration having been had, it is

ORDERED, that the issuance of injunction herein, pursuant to the terms of the interlocutory decree made and entered herein on the 20th day of April, 1905, be and hereby is stayed, upon the filing by defendant of a bond in the sum of Five Thousand Dollars and its approval as to sufficiency of surety by a judge of this Court, within ten days, until the hearing and determination, in due course, of an appeal to be taken from the interlocutory decree aforesaid to the United States Circuit Court of Appeals.

WM. K. TOWNSEND,
U. S. Judge.

Defendant's Appeal.

UNITED STATES CIRCUIT COURT,

SOUTHERN DISTRICT OF NEW YORK.

THE AUTOMATIC SWITCH COMPANY OF BALTIMORE CITY, Complainant, AGAINST THE CUTLER-HAMMER MANUFACTURING COMPANY, Defendant.	In Equity, No. 7827

The above-named defendant, The Cutler-Hammer Manufacturing Company, conceiving itself to be aggrieved by the decree made and entered on the 20th day of April, 1905, in the above-entitled cause, does hereby appeal from the said order and decree to the United States Circuit Court of Appeals for the Second Circuit, for the reasons specified in the assignment of errors, which is filed herewith, and prays that this its appeal may be allowed, and that a transcript of the record and papers upon which said order was made and of all the proceedings in the cause, duly authenticated, may be sent to the United States Circuit Court of Appeals for the Second Circuit.

Dated New York City,

SEWARD DAVIS,
JONES & ADDINGTON,
Solicitors for Defendant.

The foregoing claim of appeal is allowed.
Dated, New York City, May 12th, 1905.

E. HENRY LACOMBE,
U. S. Circuit Judge.

At a Stated Term of the Circuit Court of the United States for the Southern District of New York held in the Court Room thereof in the Post Office Building in the Borough of Manhattan and City of New York, this 26th day of May, 1905.

Present: Hon. William K. Townsend,
U. S. Circuit Judge.

Automatic Switch Company of Baltimore City, vs. Cutler-Hammer Mfg. Co.	In Equity. No. 7827. On Whittingham Patent No. 499,769.

Final Decree as to Claims 6, 7, and 8.

This cause coming on to be heard before me on January 13, 1905, upon amended bill of complaint, Answer, Replication, and proofs and exhibits on behalf of each party; and Philip Mauro, Esq., and C. A. L. Massie, Esq., having been heard for complainant, and W. Clyde Jones, Esq., for defendant; and printed briefs having been submitted on each side; and a written opinion having been filed herein on March 3, 1905; and an Interlocutory Decree in accordance therewith entered on April 20, 1905, holding Claims 4 to 8 inclusive of the Whittingham patent here in suit to be good and valid in law, but awarding complainant an injunction and accounting only as to Claims 4 and 5 with only one-half of its taxable costs (all as will more fully appear by said Interlocutory Decree itself on file in this Court); now, in further conformity with

said opinion, and on motion of Elisha K. Camp, Esq., Complainant's solicitor, it is this day

ADJUDGED, ORDERED, AND DECREED that the bill of complaint herein be and the same hereby is dismissed as to Claims 6, 7, and 8 of the Whittingham patent here in suit, as not being infringed by defendant; and that the provision of the said Interlocutory Decree as to costs be reaffirmed.

WM. K. TOWNSEND,
U. S. C. J.

Complainant's Appeal.

IN THE CIRCUIT COURT OF THE UNITED STATES

FOR THE SOUTHERN DISTRICT OF NEW YORK.

AUTOMATIC SWITCH COMPANY OF BALTIMORE CITY, vs. CUTLER-HAMMER MFG. COMPANY.	In Equity, No. 7827.

Appeal.

The above-named complainant, considering itself aggrieved by the Final Decree of this Court, filed and entered herein on the 26th day of May, 1905, and dismissing the bill of complaint herein as to Claims 6, and 7, and awarding complainant only one-half its taxable costs and disbursements, does hereby appeal to the United States Circuit Court of Appeals for the Second Circuit, and prays that its appeal may be allowed and citation granted, directed to the above-named defend-

ant, and commanding it to appear before the said Cir-Cuit Court of Appeals, to do and receive what may appertain to justice to be done in the premises, and that a transcript of the pleadings and proofs, exhibits, evidence, records and proceedings in said cause, duly authenticated, may be sent to the United States Circuit Court of Appeals for the Second Circuit.

Dated New York City, June 7, 1905.

ELISHA K. CAMP,
Solicitor for Complainant,
90 West Broadway,
New York City.

The proper security for costs having been given herein in the sum of $250.00, and the Undertaking being now in full force and effect and on file in the Office of the Clerk of this Court, it is

ORDERED that the foregoing appeal be and the same is hereby allowed.

Dated June 7, 1905.

E. H. LACOMBE,
U. S. C. J.

IN THE CIRCUIT COURT OF THE UNITED STATES

FOR THE SOUTHERN DISTRICT OF NEW YORK.

AUTOMATIC SWITCH COMPANY OF BALTIMORE CITY, vs. CUTLER-HAMMER MFG. CO.	In Equity No. 7827. On Whittingham Patent No. 499,769.

Assignment of Errors.

And now comes the above-named Automatic Switch Company of Baltimore City, complainant and cross-appellant herein, by Elisha K. Camp, Esq., its solicitor, and having prayed an appeal to the United States Circuit Court of Appeals for the Second Circuit from the "Final Decree as to Claims 6, 7, and 8" of the said Circuit Court entered herein on the 26th day of May, 1905, respectfully represents as grounds for appeal, and as an assignment of errors herein, that the Circuit Court erred in the following particulars:

1. The Court erred in dismissing the bill as to Claims 6 and 7 of the patent in suit;

2. The Court erred in not holding Claim 6 of the patent in suit to be infringed by defendant's apparatus;

3. The Court erred in not holding Claim 7 of the patent in suit to be infringed by defendant's apparatus;

4. The Court erred in not granting an injunction and accounting against defendant as to Claim 6;

5. The Court erred in not granting an injunction and accounting against defendant as to Claim 7;

6. The Court erred in not holding that the mass of iron at the top of defendant's apparatus is the iron cap of the patent in suit or the equivalent thereof;

7. The Court erred in limiting complainant to the recovery of only one-half its costs;

WHEREFORE, the complainant prays that the final decree aforesaid may be reversed and annulled as to said Claims 6 and 7; and that this Court be directed to enter a decree ordering (in addition to the relief granted in and by said Interlocutory Decree of April 20, 1905), an injunction and accounting as to said Claims 6 and 7, with all costs to Complainant.

New York City, June 7, 1905.

ELISHA K. CAMP,
Solicitor for Complainant.

Motion to Dismiss.

UNITED STATES CIRCUIT COURT OF APPEALS

FOR THE SECOND JUDICIAL CIRCUIT.

AUTOMATIC SWITCH COMPANY OF BALTIMORE CITY, Complainant-Appellee and Cross-Appellant, AGAINST THE CUTLER-HAMMER MANUFACTURING COMPANY, Defendant-Appellant and Cross-Appellee.	In Equity, Calendar No. 118

SIR: Please take notice that on Tuesday, October 10, 1905, at the opening of the United States Circuit Court of Appeals, or as soon thereafter as the matter

can be heard, a motion will be made on behalf of The Cutler-Hammer Manufacturing Company to dismiss the cross-appeal of the said Automatic Switch Company of Baltimore City.

The ground upon which said motion will be based is that the court has no jurisdiction to entertain the said cross-appeal.

Dated, New York, N. Y., September 23, 1905.

SEWARD DAVIS,
Solicitor for The Cutler-Hammer Manufacturing Company, Defendant-Appellant and Cross-Appellee,
29 Liberty Street,
Borough of Manhattan,
New York City.

ELISHA K. CAMP, ESQ.,
Solicitor for Automatic Switch Company of Baltimore City, Complainant-Appellee and Cross-Appellant, 90 West Broadway, Borough of Manhattan, New York City.

Order of Dismissal.

IN THE UNITED STATES CIRCUIT COURT OF APPEALS

FOR THE SECOND CIRCUIT.

Present: HONS. W. J. WALLACE, E. H. LACOMBE, and A. C. COXE, United States Circuit Judges.

AUTOMATIC SWITCH COMPANY OF BALTIMORE CITY, Complainant-Appellee and Cross-Appellant, vs. THE CUTLER-HAMMER MFG. CO., Defendant-Appellant and Cross-Appellee.	In Equity. Calendar No. 118.

This cause coming on to be heard upon motion by the said Cutler-Hammer Mfg. Company to dismiss the cross-appeal of the said Automatic Switch Company of Baltimore City, upon the ground that this Court has no jurisdiction to entertain the said cross-appeal; and W. Clyde Jones, Esq., being heard for the motion, and C. A. L. Massie, Esq., being heard in opposition, and each party having filed a printed brief; and the Court being duly advised in the premises;

Now, therefore, it is hereby adjudged, ordered, and decreed that the said motion be and the same hereby is granted and that the said cross-appeal taken by the said Automatic Switch Company of Baltimore City be and the same hereby is dismissed upon the ground that this Court has no jurisdiction to entertain the same.

Dated Jan. 3/06.

(Sgd) E. H. L.
A. C. C.

FOLDOUT(S) IS/ARE TOO LARGE TO BE FILMED

Supreme Court of the United States,

No. 18, ORIGINAL, OCTOBER TERM, 1905.

Ex parte

IN THE MATTER

OF

AUTOMATIC SWITCH COMPANY OF BALTIMORE CITY,

Petitioner.

The return of the Judges of the United States Circuit Court of Appeals for the Second Circuit to the rule upon them to show cause why a writ of peremptory mandamus should not issue commanding them in said court to entertain an appeal of said petitioner from a decree entered in the cause entitled Automatic Switch Company of Baltimore City vs. The Cutler Hammer Manufacturing Company.

The respondents respectfully answer and certify to the Honorable Supreme Court of the United States:

(1) That after pleadings filed and issue joined in said cause and after arguments of counsel for both sides, and final hearing upon proofs theretofore taken in said cause, the Honorable WILLIAM K. TOWNSEND, Circuit Judge, sitting as a Judge of the United States Circuit Court for the Southern District of New York, filed on March 3rd, 1905 an opinion finding infringement of claims 4 and 5 of letters patent No. 499,769, granted June 20, 1893 to G. H. Whittingham for a Regulator

for Electric Motors, and finding claims 6, 7 and 8 of said letters patent not infringed.

(2) That thereafter an interlocutory decree was entered by said Circuit Judge, the same having been filed April 20th, 1905, and reading as follows, to wit:

"At a Stated Term of the Circuit Court of the United States for the Southern District of New York, held in the Court Room thereof in the Federal Building, in the Borough of Manhattan and City of New York, this 20th day of April, 1905.

"Present—HON. WILLIAM K. TOWNSEND,
United States Circuit Judge.

"AUTOMATIC SWITCH COMPANY OF BALTIMORE CITY

vs.

"CUTLER-HAMMER MANUFACTURING COMPANY.

In Equity.
No. 7827.
On Whittingham Patent No. 499,769.

"INTERLOCUTORY DECREE.

"This cause having come on to be heard on Jan. 13, 1905, upon amended bill of complaint, answer, replication, and proofs and exhibits on behalf of each party; and Philip Mauro, Esq., and C. A. L. Massie, Esq., having been heard for complainant, and W. Clyde Jones, Esq., for defendant, and printed briefs having been submitted on each side, and a written opinion having been entered herein on Mar. 3, 1905, now, in conformity with said opinion, and on motion of Complainant's Solicitor, Elisha K. Camp, Esq., it is this day

"Adjudged, ordered and decreed that complainant is a Maryland corporation, entitled to maintain this suit and is possessed of the exclusive and beneficial ownership of the Letters Patent here in suit and of the invention therein set out and of all claims for infringement

thereof; that the said Letters Patent No. 499,769, granted June 20, 1893, to George Herbert Whittingham, as to Claims 4, 5, 6, 7 and 8 thereof, is good and valid in law; and that defendant has a regular and established place of business within the Southern District of New York, and has infringed upon Claims 4 and 5 of said Letters Patent and upon complainant's exclusive rights in the premises, by making and causing to be made, using and causing to be used, and selling and causing to be sold, within the Southern District of New York and elsewhere within the United States, 'Regulators for Electric Motors' or 'Automatic Switches' like 'Complainant's Exhibit, Defendant's Apparatus'; known also as Cutler-Hammer 'Self Starters'; it is further

"Adjudged, ordered and decreed that a perpetual injunction issue out of and under the seal of this Honorable Court against the defendant, enjoining and restraining said defendant, and its successors, assigns, associates, attorneys, officers, servants, clerks, agents, and workmen, and each of them, forever from directly or indirectly making or causing to be made, using or causing to be used, selling or causing to be sold, any regulator for Electric Motors or Automatic Switch or Self Starter like or substantially similar to the construction set forth in Claims 4 and 5 of said Letters Patent No. 499,769, or in either of said Claims; or like or substantially similar to the 'Self Starter' apparatus made an exhibit herein, as 'Complainant's Exhibit, Defendant's Apparatus'; it is further

"Adjudged, ordered and decreed that this cause be referred to John A. Shields, Esquire, one of the Masters of this Court, he being especially qualified by reason of his experience in these matters, to ascertain and report to this Court an account of the number of infringing Automatic Switches or Self Starters, either directly or indirectly, made or used or sold, by the said defendant in infringement of Claims 4 and 5 of the patent in suit, likewise of the number of such articles which the said defendant has on hand or under its control, and also a statement of the gains, profits and advantages

which the said defendant has received or which have accrued to it from or through the said infringement, and, further, to assess the damages the complainant has suffered in the premises, and to report all the foregoing to this Court with all convenient speed;

"And that upon such an accounting the complainant shall have the right to cause an examination of said defendant *ore tenus*, by commission, or otherwise, and also the production of the books, vouchers, exhibits, statements, documents and machinery and premises of said defendant, as the said Master may direct; and that the said defendant attend for such purpose from time to time as the said Master shall direct; and it is further

"Adjudged, ordered and decreed that the defendant pay to the complainant one-half of the costs, charges and disbursements of this suit, to be taxed by the Clerk; and that complainant have execution therefor against said defendant.

"W. K. TOWNSEND,
U. S. Circuit Judge.

"Approved as to form.

"(ENDORSED)—In the Circuit Court of the United States, for the Southern District of New York.—Automatic Switch Company vs. Cutler-Hammer Mfg. Co. In Equity, Docket No. 7827, Whittingham Patent, —Interlocutory Decree for Injunction.—Philip Mauro. For Complainant, 277 Broadway, New York City.—March 7, 1905.—Copy received at 2.55 P. M. Seward Davis. And notice objected to as insufficient.—U. S. Circuit Court, Southern District of New York.—Filed Apr. 20, 1905.—John A. Shields, Clerk."

(3) That thereafter an appeal was taken by defendant, The Cutler-Hammer Mfg. Co., from said interlocutory decree, filed April 20, 1905, said appeal and the allowance thereof being as follows, to wit:

"UNITED STATES CIRCUIT COURT,

"SOUTHERN DISTRICT OF NEW YORK.

"THE AUTOMATIC SWITCH COMPANY OF BALTIMORE CITY, Complainant, AGAINST "THE CUTLER-HAMMER MANUFACTURING COMPANY, Defendant.	In Equity. No. 7827.

"The above named defendant, The Cutler-Hammer Manufacturing Company, conceiving itself to be aggrieved by the decree made and entered on the 20th day of April, 1905, in the above entitled cause, does hereby appeal from the said order and decree to the United States Circuit Court of Appeals for the Second Circuit, for the reasons specified in the Assignment of errors, which is filed herewith, and prays that this its appeal may be allowed, and that a transcript of the record and papers upon which said order was made and of all the proceedings in the cause, duly authenticated, may be sent to the United States Circuit Court of Appeals for the Second Circuit.

"Dated New York City, May 12, 1905.

"SEWARD DAVIS,
"JONES & ADDINGTON,
"Solicitors for Defendant.

"The foregoing claim of appeal is allowed.

"Dated New York City, May 12, 1905.

"E. HENRY LACOMBE,
"U. S. Circuit Judge.

"[ENDORSED.] United States Circuit Court, Southern District of New York.—In Equity, No. 7827.—The Au-

tomatic Switch Company of Baltimore City, Complainant, against The Cutler-Hammer Manufacturing Company, Defendant.—Petition for an allowance of Appeal. —Seward Davis, Jones & Addington, Solicitors for Defendant, 29 Liberty Street, New York City.—Due service of the within Petition for an Allowance of Appeal is hereby admitted this 13th day of May, 1905.—Elisha K. Camp, Solicitor for Complainant.—U. S. Circuit Court, Southern District of New York.—Filed May 13, 1905.—John A. Shields, Clerk."

(4) That an assignment of errors was filed by said defendant May 12th, 1905.

(5) That citation to the Automatic Switch Company of Baltimore City, complainant, pursuant to the appeal by defendant was issued and duly served upon complainant, said citation being as follows, to wit :

" UNITED STATES CIRCUIT COURT OF APPEALS,

" FOR THE SECOND CIRCUIT.

" UNITED STATES OF AMERICA, } ss. :
" Second Judicial Circuit, }

TO THE AUTOMATIC SWITCH COMPANY OF BALTIMORE CITY, GREETING :

" You are hereby cited and admonished to be and appear at a session of the United States Circuit Court of Appeals for the Second Circuit, to be holden at the City of New York in said Circuit, on the 9th day of June, 1905, pursuant to the petition for appeal filed in the Clerk's Office of the Circuit Court of the United States for the Southern District of New York, and duly allowed, wherein The Cutler-Hammer Manufacturing Company is defendant-appellant and The Automatic Switch Company of Baltimore City is complainant-appellee, to show cause, if any there be, why the interlocutory decree granted against the said defendant-

appellant, as in the said petition for appeal mentioned, should not be corrected, and why speedy justice should not be done to the parties in that behalf.

"Witness, the Honorable E. HENRY LACOMBE, Circuit Judge of the United States at the City of New York, within said Circuit, this 12th day of May, in the year of our Lord one thousand nine hundred and five, and of the Independence of the United States the one hundred and twenty-ninth.

"E. HENRY LACOMBE,
"United States Circuit Judge.

"[ENDORSED]—United States Circuit Court, Southern District of New York. In Equity, No. 7827.—The Automatic Switch Company, of Baltimore City, Complainant, against the Cutler-Hammer Manufacturing Company, Defendant.—Citation on Appeal.—Seward Davis, Solicitor for Defendant, 29 Liberty Street, New York City.—Due service of the within Citation on appeal is hereby admitted this 13th day of May, 1905.—Elisha K. Camp, Solicitor for Complainant.—U. S. Circuit Court, Southern District of New York.—Filed May 13, 1905.—John A. Shields, Clerk."

(6) That thereafter a second decree was entered and filed in said cause, said decree having been filed May 26th, 1905, the decree and the affidavit of service thereof reading as follows, to wit:

"At a Stated Term of the Circuit Court of the United States for the Southern District of New York, held in the Court Room thereof, in the Post-Office Building, in the Borough of Manhattan and City of New York, this 26th day of May, 1905.

"Present—HON. WILLIAM K. TOWNSEND,
"U. S. Circuit Judge.

AUTOMATIC SWITCH COMPANY OF BALTIMORE CITY vs. CUTLER-HAMMER MFG. CO.	In Equity, No. 7827. On Whittingham Patent No. 499,769.

"FINAL DECREE AS TO CLAIMS 6, 7 AND 8.

"This cause coming on to be heard before me on January 13, 1905, upon amended bill of complaint, Answer, Replication and proofs and exhibits on behalf of each party; and Philip Mauro, Esq., and C. A. L. Massie, Esq., having been heard for complainant, and W. Clyde Jones, Esq., for defendant; and, printed briefs having been submitted on each side; and a written opinion having been filed herein on March 3, 1905; and an interlocutory Decree in accordance therewith entered on April 20, 1905, holding Claims 4 to 8 inclusive of the Whittingham patent here in suit to be good and valid in law, but awarding complainant an injunction and accounting only as to Claims 4 and 5 with only one-half of its taxable costs (all as will more fully appear by said Interlocutory Decree itself on file in this Court); now, in further conformity with said opinion; and on motion of Elisha K. Camp, Esq., Complainant's solicitor, it is this day

"Adjudged, ordered and decreed that the bill of complainant herein be and the same hereby is dismissed as to Claims 6, 7 and 8 of the Whittingham

patent here in suit, as not being infringed by defendant; and that the provision of the said Interlocutory decree as to costs be reaffirmed.

" Wm. K. Townsend,
" *U. S. C. J.*

" IN THE CIRCUIT COURT OF THE UNITED STATES.

" For the Southern District of New York.

" Automatic Switch Company of Baltimore City vs. Cutler-Hammer Mfg. Co.	In Equity. No. 7827. On Whittingham Patent No. 499,769.

" Harting Affidavit of Service.

" State of New York, } ss.
" County of New York, }

Willard H. Harting, being duly sworn, deposes and says: That he is twenty-one years of age and upwards. That on the 22nd day of May, 1905, between the hours of three and four o'clock P. M., at the office of Seward Davis, Esq., 29 Liberty Street, Borough of Manhattan, City of New York, he served a copy of the annexed Notice and Final Decree as to claims 6, 7 and 8 upon Seward Davis, Esq., in this action by delivering to and leaving with the said Seward Davis, Esq., personally, a true copy thereof.

" Willard H. Harding.

" Subscribed and sworn to before me this 22nd day of May, 1905.

Elisha K. Camp,
Notary Public,
New York County.

(Seal.)

" (Endorsed)—In the Circuit Court of the United States for the Southern District of New York.—Auto-

matic Switch Company of Baltimore City vs. Cutler-Hammer Mfg. Co.—In Equity, Docket No. 7827.—Whittingham Patent No. 499,769—Notice and Final Decree as to Claims 6, 7 and 8 and affidavit of service. —Philip Mauro, for Complainant, 90 West Broadway, New York City.—U. S. Circuit Court, Southern District of New York.—Filed May 26, 1905.—John A. Shields, Clerk."

(7) That thereafter complainant appealed from said second decree, said appeal having been filed June 7th, 1905, and reading as follows, to wit :

"IN THE CIRCUIT COURT OF THE UNITED STATES

"FOR THE SOUTHERN DISTRICT OF NEW YORK.

"AUTOMATIC SWITCH COMPANY OF BALTIMORE CITY vs. CUTLER-HAMMER MFG. COMPANY.	In Equity. No. 7827.

"APPEAL.

"The above-named complainant, considering itself aggrieved by the Final Decree of this Court, filed and entered herein on the 26th day of May, 1905, and dismissing the bill of complaint herein as to claims 6 and 7, and awarding complainant only one-half its taxable costs and disbursements, does hereby appeal to the United States Circuit Court of Appeals for the Second Circuit, and prays that its appeal may be allowed and citation granted, directed to the above-named defendant, and commanding it to appear before the said Circuit Court of Appeals to do and receive what may appertain to justice to be done in the

premises, and that a transcript of the pleadings and proofs, exhibits, evidence, records and proceedings in said cause, duly authenticated, may be sent to the United States Circuit Court of Appeals for the Second Circuit.

"Dated New York City, June 7, 1905.

"ELISHA K. CAMP,
"Solicitor for Complainant,
"90 West Broadway,
"New York City.

"The proper security for costs having been given herein in the sum of $250.00, and the Undertaking being now in full force and effect and on file in the Office of the Clerk of this Court, it is

"Ordered, that the foregoing appeal be and the same is hereby allowed.

"Dated June 7, 1905.

"E. H. LACOMBE,
"*U. S. C. J.*

"(ENDORSED)—In the Circuit Court of the United States for the Southern District of New York.—Automatic Switch Company of Balimore City vs. Cutler-Hammer Mfg. Co.—In Equity, Docket No. 7827.—Appeal.—Philip Mauro, for Complainant-Appellant, 90 West Broadway, New York City.—Due and timely service of a copy of the within Appeal is hereby admitted.—Dated June 7, 1905.—Seward Davis, Solicitor for Defendant.—U. S. Circuit Court, Southern District of New York.—Filed Jun. 7, 1905.—John A. Shields, Clerk."

(8) That an assignment of errors was filed by complainant June 7th, 1905, said assignment of errors reading as follows, to wit:

" IN THE CIRCUIT COURT OF THE UNITED STATES

" FOR THE SOUTHERN DISTRICT OF NEW YORK.

" AUTOMATIC SWITCH COMPANY OF BALTIMORE CITY VS. " CUTLER-HAMMER MFG. CO.	In Equity. No. 7827 On Whittingham Patent No. 499,769.

" ASSIGNMENT OF ERRORS.

" And now comes the above-named Automatic Switch Company of Baltimore City, complainant and cross-appellant herein, by Elisha K. Camp, Esq., its solicitor, and having prayed an appeal to the United States Circuit Court of Appeals for the Second Circuit from the 'Final Decree as to Claims 6, 7 and 8' of the said Circuit Court entered herein on the 26th day of May, 1905, respectfully represents as grounds for appeal, and as an assignment of errors herein, that the Circuit Court erred in the following particulars :

" 1. The Court erred in dismissing the bill as to Claims 6 and 7 of the patent in suit ;

" 2. The Court erred in not holding Claim 6 of the patent in suit to be infringed by defendant's apparatus ;

" 3. The Court erred in not holding Claim 7 of the patent in suit to be infringed by defendant's apparatus ;

" 4. The Court erred in not granting an injunction and accounting against defendant as to Claim 6 ;

" 5. The Court erred in not granting an injunction and accounting against defendant as to claim 7 ;

" 6. The Court erred in not holding that the mass of iron at the top of defendant's apparatus is the iron cap of the patent in suit or the equivalent thereof ;

" 7. The Court erred in limiting complainant to the recovery of only one-half its costs ;

" Wherefore, the complainant prays that the final decree aforesaid may be reversed and annulled as to said

Claims 6 and 7; and that this Court be directed to enter a decree ordering (in addition to the relief granted in and by said interlocutory decree of April 20, 1905), an injunction and accounting as to said Claims 6 and 7, with all costs to Complainant.

" New York City, June 7th, 1905.

" ELISHA K. CAMP,

" Solicitor for Complainant.

" (ENDORSED:)—In the Circuit Court of the United States for the Southern District of New York.—Automatic Switch Company of Baltimore City vs. Cutler-Hammer Mfg. Co.—In Equity, Docket No. 7827.—Assignment of Errors.—Philip Mauro, for Complainant, 90 West Broadway, New York City.—U. S. Circuit Court, Southern District of New York.—Filed Jun. 7, 1905.—John A. Shields, Clerk."

(9) That thereafter a transcript of the record and proceedings had in the Circuit Court was prepared by John A. Shields, Clerk of said Circuit Court and certified to by him June 9th, 1905.

(10) That thereafter, on June 9th, 1905, said transcript was filed with the clerk of the United States Circuit Court of Appeals for the Second Circuit.

(11) That in accordance with the rules and practice of said Circuit Court, where an appeal is taken by both the complainant and the defendant, the parties may agree that one certification and one transcript of record may be made up, containing the papers and documents upon which both parties expect to rely, the cost thereof to be equally borne by the parties in the first instance, the apportionment of the costs thereafter to be determined by the Circuit Court of Appeals; that a joint record in this cause was made up by the complainant and defendant after the two appeals had been allowed.

(12) That on October 10, 1905, motion was made by defendant to dismiss complainant's appeal on the ground that this court has no jurisdiction to entertain the said appeal of

complainant; that said motion was thereafter set for oral argument and arguments were made by W. Clyde Jones, Esq., in support of the motion and by C. A. L. Massie, Esq., in opposition to the motion; that briefs were thereupon filed by both parties and after a consideration thereof, an order was entered by this court on January 3rd, 1906, granting said motion and dismissing the appeal of complainant, said order being as follows, to wit:

"IN THE UNITED STATES CIRCUIT COURT OF APPEALS

"For the Second Circuit.

"Present: Hons. W. J. Wallace, E. H. Lacombe, and A. C. Coxe, United States Circuit Judges.

"Automatic Switch Company of Baltimore City, "Complainant-Appellee and "Cross-Appellant, vs. "The Cutler-Hammer Mfg. Co., "Defendant-Appellant and "Cross-Appellee.	In Equity, Calendar No. 118.

"This cause coming on to be heard upon motion by the said Cutler-Hammer Mfg. Company to dismiss the cross-appeal of the said Automatic Switch Company of Baltimore City, upon the ground that this Court has no jurisdiction to entertain the said cross-appeal; and W. Clyde Jones, Esq., being heard for the motion, and C. A. L. Massie, Esq., being heard in opposition, and each party having filed a printed brief; and the Court being duly advised in the premises;

"Now, therefore, it is hereby ADJUDGED, ORDERED and DECREED that the said motion be and the same hereby is granted and that the said cross-appeal taken by the said Automatic Switch Company of Baltimore City be and

the same hereby is dismissed upon the ground that this Court has no jurisdiction to entertain the same.

" Dated, Jan. 3, 1906.

" A true copy.

" (Signed) WM. PARKIN,

" Clerk (SEAL).

(Sgd)
E. H. L.
A. C. C.
" Filed Jan. 3, 1906."

(13) Respondents denied the appeal by complainant for the reason that in the opinion of this court, this court was without jurisdiction to entertain said appeal and respondents now submit that no appeal was or is now demandable in law from the said decree from which complainant undertook to appeal.

(14) Respondents are advised that it is not necessary that they should make any other answer to the rule aforesaid than this herein contained, nor more specifically to any of the allegations set forth in the petition for mandamus aforesaid; and having fully answered said rule, they pray to be hence dismissed with all proper costs. And these are the causes and reasons which these respondents have offered why a mandamus should not issue, commanding them to entertain said appeal; but they respectfully submit to the judgment of this Honorable Court and will enforce by order, any direction given by the court in the premises.

WILLIAM J. WALLACE.

In signing the return we do not assent to the precise form in which the statement contained in paragraph (13) is expressed. It is our understanding that the appeal was dismissed because this court was of the opinion that the rule of *stare decisis* should control, and that whatever might be the individual opinions of the sitting members of the court, or of the majority thereof, the practice heretofore prevailing in this circuit should be followed.

E. H. LACOMBE,
ALFRED C. COXE,
U. S. Circuit Judges.